

### **REMARKS**

The Office Action of December 28, 2011, and the prior art relied upon therein, including the newly cited and applied Stangl reference, have been carefully reviewed. Applicant resolutely maintains that the claims not only define novel subject matter, but also define non-obvious subject matter and thus meet the patentability requirements of 35 USC §103. The claims should be allowed, whereby favorable reconsideration and allowance are earnestly solicited.

Claim 1 (therefore including all of Applicant's claims) is amended above to explicitly set forth that the first body (2) of Applicant's claimed device has:

- (i) a first outlet (3a) which is used to put in contact with the user's mouth, and is arranged outside the receptacle (5) of the second body (4); and
- (ii) a second outlet (3b) which is arranged inside the receptacle (5) of the second body (4).

In addition, claim 3 is amended in a minor way to better conform with claim 2 from which it depends. Support for the amendment to claim 1 should be clear from Applicant's specification and drawings in general, although particular attention is invited to page 5, lines 26-29, with respect to the first outlet (3a).

The added feature (see above) explicitly provides the structure in which the first body (2) exits from the second body (4), whereby the first body can be easily held by the user and rotated with respect to the second body (4).

Claims 1, 3, 4, 8 and 9 have been rejected as obvious under §103 from Knupp in view of Stangl et al U.S. Patent Publication 2003/0164169 (Stangl) and Thompson. This rejection is respectfully traversed for the reasons of record as regards Knupp and Thompson, and for the further reasons set forth below.

According to the Rejection, "Stangl teaches a powder medicament (6a) that can be released as a single dose into an inhalation passageway," and therefore it "would have been obvious to one of ordinary skill in the art at the time the invention was

made to modify Knupp's medicament with a powder medicament, as taught by Stangle, for the purpose of providing a different medicament to the user depending on their needs." Also, according to the Rejection, Knupp "is silent regarding that the second body has a second outlet arranged on the outer surface of one end of the second body," but that "Thompson teaches [Fig. 1] a body with a through channel (between 32 and 24) having a second outlet (one of the 24 openings) arranged on the outer surface of an end of the body," whereby it "would have been obvious... to modify Knupp's second body at a right portion of H and 20 with a through channel and second outlets at 24 and 32, as taught by Thompson, for the purpose of providing potentially more than one gas to the system." Applicant respectfully disagrees.

First, Applicant respectfully repeats by reference Applicant's earlier remarks concerning Knupp and Thompson, and the reasons previously set forth as to why such combination would not have been obvious, and in any event would not have provided the claimed subject matter. The Office Action states at page 7, paragraph 5 that Applicant's earlier arguments "have been considered but are moot in view of the new grounds of rejection." But Stangl, the only new reference, has only been cited for the purported obviousness of substituting powder for liquid, and has little or nothing to do with Applicant's previous remarks against the prior rejection based on Knupp modified by Thompson. Respectfully, Applicant deserves and is entitled to an answer or rebuttal of Applicant's earlier arguments. Respectfully, the case law is replete with prior decisions which indicate that the PTO is not justified in simply ignoring an applicant's earlier arguments. MPEP 707.07(f) confirms the requirement imposed on the PTO to answer or rebut an applicant's arguments.<sup>1</sup>

Applicant respectfully reiterates the previous arguments that Knupp and Thompson are so different from one another that their combination would not even have been contemplated; but if contemplated, their structures are so different that the person

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<sup>1</sup> MPEP 706.07 is similar regarding a response in a Final Rejection to an applicant's arguments.

of ordinary skill in the art could not put them together in such a way as to come up with Applicant's claimed structure.

The rejection says that the person of ordinary skill in the art would have modified Knupp's second body to provide a through channel and second outlets at 24 and 32 of Thompson "for the purpose of providing potentially more than one gas to the system." Why would the person of ordinary skill in the art want to do that in the Knupp device? There is no reason to so modify Knupp, and the use of a second gas in Knupp is unsupported speculation. Above and beyond that, where would such Thompson structure be placed in the Knupp device? Such an addition to or modification of Knupp makes no sense.

Moreover, even if such a substitution were obvious, and even if such a substitution could be made, Applicant's device as called for in claim 1 (even as previously drafted) would not be provided. It would only be Knupp's device with an extra opening (between elements 24 and 32 of Thompson), somewhere in the Knupp device (where?), and with no relevant purpose in Knupp.

The combination of Knupp modified by Thompson, as presently urged (and as urged previously), would not have been obvious to produce Applicant's construction, either as claimed previously or presently.

Nevertheless, and as pointed out above, Applicant's claim 1 has been further amended to provide another important difference between the present invention and Knupp in that in the present invention the first body (2) has (i) a first outlet (3a) for the dosed material to the user, which is outside the receptacle (5) of the second body (4), and (ii) a second outlet (3b) which is inside the receptacle (5) of the second body (4). Also as noted above as a result of the added features, the first body (2) can be easily held by the user and rotated with respect to the second body (4).

In Knupp, on the contrary, the inner sheet 12 is completely inside the outer sheet 14, as stated in the passage of column 4, lines 31-38. In order to rotate the inner sheet 12 with respect to the outer sheet 14, the valve of Knupp is provided with a control knob 16 integral with the inner sheet 12 and extending through the opening 18 in

the outer sheet 14. But this solution is very complicated. Indeed, when the control knob 16 is associated to the inner sheet 12, the inner sheet 12 cannot be inserted inside the outer sheet 14. It follows that, in order to mount the valve of Knupp, the inner sheet 12 needs to be produced separated from die control knob 16, and then it is inserted inside the outer sheet 14, where the control knob 16 is associated to the inner sheet 12, for example by gluing or welding. The Knupp teaching means that Knupp is produced in at least three pieces which need a difficult and problematic assembly phase. The present invention, on the contrary, consists in only two pieces which are easily mounted by inserting one inside the other.

Neither Thompson nor Stangl make up for this additional deficiency in Knupp. Again, the references do not make the claimed device obvious to the person of ordinary skill in the art.

Withdrawal of the rejection is in order and is respectfully requested.

Claims 5-7 and 10 have been rejected as obvious under §103 from Knupp, Stangl and Thompson as applied against claim 1, further in view of Anderson, previously applied. This rejection is respectfully traversed, again for the reasons of record as regards Knupp, Thompson and Anderson, and further as noted below.

Claims 5-7 and 10 depend directly or ultimately on claim 1, and thus incorporate the features of claim 1. Anderson has not been relied upon to make up for the deficiencies noted above regarding the rejection of claim 1, and Applicant agrees that Anderson does not make up for such deficiencies. Therefore, claim 5-7 and 10 are patentable for the reasons pointed out above with regard to the patentability of claim 1, even ignoring the added features of claims 5-7 and 10.

With respect to the features added to claim 1 above, Anderson also does not have a first body which exits from the second body and which can be rotated the same as or similar to the present invention.

For the record, Applicant also does not agree that Anderson make obvious the features in the dependent parts of claims 5-7 and 10, or at least all of the features of

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these claims, nor does Applicant agree that it would have been obvious to further modify Knupp by Anderson, after Knupp has been already modified by Stangl and Thompson (if such modifications were obvious, contrary to Applicant's position). Applicant respectfully reserves the right to elaborate in the future, should it become necessary to do so, but Applicant does not do so at present to avoid prolixity.

Withdrawal of the rejection is thus in order and respectfully requested.

**In view of the inability to make further amendments after final action, and in view of the new docketing procedure in the PTO where an application in which a Request for Continued Examination (RCE) has been filed is more or less put at the end of the line and it often takes more than one year for an application containing an RCE to be examined (a year and a half elapsed in the present application between the filing of an RCE on July 15, 2010, and the last Action on December 28, 2011), Applicants request and would very much appreciate a call from the Examiner before the issuance of any final action so that the present application can be discussed and any resolvable problems resolved by oral discussion before the issuance of any final action.**

The prior art documents of record and not relied upon by the PTO have been noted, along with the implication that such documents are deemed by the PTO to be insufficiently material to warrant their application against any of Applicants' claims.


Applicants believe that all issues raised in the Office Action have been addressed above in a manner that should lead to patentability of the present application. Favorable consideration and allowance are respectfully requested.

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Again, if the Examiner has any questions or suggestions, the Examiner is respectfully invited and requested to contact the undersigned at (202) 628-5197.

Respectfully submitted,

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